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09/238,821	01/28/1999	JOSEPH PHILLIP BIGUS	R0998-238	5818
7590 STEVEN W ROTH IBM CORPORATION DEPARTMENT 917 3605 HIGHWAY 52 NORTH ROCHESTER, MN 559017829				
EXAMINER AKINTOLA, OLABODE				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/238,821
Filing Date: January 28, 1999
Appellant(s): BIGUS, JOSEPH PHILLIP

Roy W. Truelson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 18, 2011 appealing from the Office action mailed December 13, 2010.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,522,875	Dowling et al.	02-2003
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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said information" in line 14. It is not clear what this information refers to. Is it item information or order information? Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 9, 11-13, 18, 24-26, 32, 34-36, 41, 46, 48-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Dowling et al (USPN 6522875).

Re claims 1, 11-13, 24, 34-35, 46, 49, 50-53: Dowling teaches a method for servicing a customer, said method being carried out by a first computer system and comprising the steps of: transmitting, from said first computer system, item information (*via broadcast within a range*), said item information comprising information about available items (*for example available local restaurants*), said item information being transmitted as a first wireless transmission (abstract, col. 4, lines 9-30, col. 3, lines 20-42, col. 2, lines 13-19, 40-50); retransmitting, from said first computer system, said item information, said item information being retransmitted as a second wireless transmission (abstract, col. 4, lines 9-30, col. 3, lines 20-42, col. 2, lines 13-19, 40-50); and receiving at said first computer system order information from at least a second computer system, said order information comprising at least one user-selected item from said item information, said second computer system being moved by a customer from a first position to a second position, wherein said first position is not within range of said first wireless transmission and wherein said second position is within range of said second wireless transmission, said information being received after said customer device is moved to said second position, said information not being received as a result of a request from said second computer system (col. 10, lines 59-61, col. 4, lines 9-30, col. 3, lines 20-42, col. 2, lines 13-19, 40-50).

Re claims 2, 25, 36 and 48: Dowling teaches wherein said item information is embodied as a menu (*pick-list menu*) (col. 10, line 60).

Re claims 3 and 26: Dowling teaches displaying said item information (col. 10, line 60).

Re claim 4: Dowling teaches wherein the first computer system is embodied as a server system and wherein the second computer system is embodied as a customer device (col. 10, lines 59-61, col. 4, lines 9-30, col. 3, lines 20-42, col. 2, lines 13-19, 40-50).

Re claims 9, 18, 32 and 41: Dowling teaches displaying said order information (col. 10, lines 59-61, col. 4, lines 9-30, col. 3, lines 20-42, col. 2, lines 13-19, 40-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5, 6-8, 10, 14, 15, 17, 19, 28-31, 33, 37, 38, 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowling.

Re claims 5, 6, 10, 14, 15, 19, 28, 29, 33, 37, 38 and 42: Dowling does not explicitly teach that the order information includes payment information and vehicle identification information; displaying said vehicle identification information. However, the differences between the prior art and the claimed limitation are only rooted in content. And content is nonfunctional descriptive material. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate, of which there is no evidence in the record. See *In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). See also *Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1103; 191 Fed. Appx. 959 (Fed. Circ. 2006) affirmed without written opinion Aug. 17, 2006). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dowling to include any type of order information in order to enhance the flexibility of the system/process.

Re claims 7, 8, 17, 30, 31 and 40: Dowling does not explicitly teach validating said order information; accepting said order information when said order information is valid; and rejecting said order information when said order information is not valid; transmitting acceptance

information to said client device when said order is valid; and transmitting error information to said client device when the order is not valid.

Official notice is hereby taken that these concepts are old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dowling to include these steps for the obvious reason of alerting the user about the validity of his input.

(10) Response to Argument

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

A. Rejection of claims 2, 11-13, 18, 25, 34-36, 41 and 51-53 under 35 U.S.C. § 102(e) as being anticipated by Dowling.

I (A): Regarding claims 2, 11-13, 18, 25, 34-36, 41 and 51-53, Appellant asserts that Dowling does not disclose the term “menu” as applied to the claims (see Appeal Brief, pages 13-14).

In Response to (1): Examiner respectfully disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., menu in the context of restaurant) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Given the broadest reasonable interpretation, menu includes any list or set of items or a list of options available to a user, as displayed on a CRT or other type of screen (see Appeal

Brief, page 13, lines 1-5). Dowling explicitly teaches "menu". For example, Dowling explicitly teaches "pick list" menu (col. 10, line 60).

Secondly, Appellant asserts that Dowling does not teach order information comprising at least one user selected item from said item information (menu).

In Response: Examiner respectfully disagrees. Again, given the broadest reasonable interpretation, "order information comprising at least one user selected item from the item information" is interpreted as a user selected URL from the list of URL presented to the user (col. 10, lines 60-61). That is, requesting to download a selected URL from the plurality of URLs presented to the user.

I (B-D): Appellant arguments are similar to that in I (A) and are similarly addressed above.

II (A-B): Examiner notes that the types of order information including payment information or vehicle identification information are considered non functional descriptive language since the claim does not recite any use for such information. It is simply considered as "data".

II (C): To adequately traverse a finding of Official Notice, an Appellant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).

A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice would be inadequate. See MPEP 2144.03. Applicant has failed to point out why these limitations are not common knowledge or well known in the art.

III: Rejection of claims 1-10 under 35 U.S.C. § 112, second paragraph, as indefinite.

Examiner notes that Amendment after Notice of Appeal is NOT entered.

Examiner asserts that the claims as written prior to the office action mailed on December 13, 2010 is indefinite as recited in the rejection above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,
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